IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Group Art Unit:	2145	)
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Examiner:	Winder, Patrice L.	)
		)
Inventor:	Levergood	)
		) **Pre-Appeal Request for Review**
Serial No.:	09/548,235	)
		)
Filed:	April 12, 2000	)
		)
For:	Web Advertising Method	)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

This pre-appeal request for review responds to the Office Action mailed on January 10, 2008.

I. The Enablement Rejection Under 35 U.S.C. § 112 Is Incomplete, Relies Upon a Faulty Understanding of the Law of Enablement, and Ignores the Clear Disclosure of the Claimed Invention in the Specification

Claims 1 and 4-65 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The only reasoning set forth in the Office Action to support the rejection of all sixty-three claims of this application, however, including ten distinct independent claims, is the following two sentences:

> Applicant's specification does not provide details as to how one of ordinary skill would implement the computer-implemented aspects of Applicant's invention (i.e. no computer code or programming comments are provided) to "determine the number of hits, hyperlinks, sales" and "charge for advertising" based on the number of hits, hyperlinks and sales. In fact the specification lacks, [sic] any details of Applicant's implementation. (Office Action at 2)

The above-quoted rationale cannot possibly support the rejection of all sixty-three pending claims for at least the following reasons. First, the rejection fails to specifically state which language of which claims is not enabled by the specification. Although referring to "'determining the number of hits, hyperlinks, sales'" and "'charge for advertising' based on the number of hits,

hyperlinks and sales," this quoted language does not appear in any of the claims of this application. There is no claim that requires "determining the number of hits, hyperlinks, sales," for example. It is apparent that the Examiner is utilizing some form of short-hand notation in rejecting the claims, but in doing so the Examiner has failed to specifically point out which claim phrases of the ten distinct independent claims is allegedly not enabled. Applicants maintain that this "short-hand" notation is clearly not the proper way to make out a *prima facie* case of non-enablement, and thus for this reason alone the rejection should be withdrawn.

Second, the rejection is faulty because it presumes that the applicants must have disclosed "computer code or programming comments" in order to satisfy the requirements of 35 U.S.C. § 112. This is clearly a faulty presumption. Applicants are unaware of any Federal Circuit precedent or any PTO regulation that would require a patent application directed to computer/software technologies to disclose "computer code or programming comments" in order to satisfy section 112. In fact, the opposite is true. In *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931 (Fed. Cir. 1990), the Federal circuit held that the district erred in holding certain claims invalid for lack of enablement where the patent specification failed to set forth a computer program for carrying out the claimed invention, *but* the great weight of the evidence indicated that "a programmer of reasonable skill could write a satisfactory program with ordinary effort." (*Id.* at 943) As set forth in claim 1 of this application, for example, the computer-implemented steps that appear to be at issue based on the Examiner's "short hand" notation are "determining accesses to the product page resulting from the link traversals to the product page," and "charging for advertising based on said determined accesses to the product page." Surely there is nothing so extraordinary about these steps that the programmer of reasonable skill couldn't write a satisfactory program with ordinary effort. The "determining" step is simply a matter of counting the number of accesses to the product page either in real time or as recorded in a database, and the "charging" step is simply a matter of setting

up a schedule of charging for advertising based on counting the number of accesses. Applicants maintain that a programmer of reasonable skill in the art, particularly upon reviewing the applicant's detailed disclosure of these steps set forth below, would be able to code a satisfactory program with ordinary effort.

Finally, the enablement rejection is faulty because it simply ignores the detailed disclosure of the patent specification that describes the claimed methodology such as described above with reference to claim 1, for example. Specifically, beginning at page 14, line 16, the specification discloses that:

> Additionally, the server may, at any given time, track access history within a client-server session. Such a history profile informs the service provider about link transversal frequencies and link paths followed by users. This profile is produced by filtering transaction logs from one or more servers to select only transactions involving a particular user ID (UID). Two subsequent entries, A and B, corresponding to requests from a given user in these logs represent a link traversal from document A to document B made by the user in question. This information may be used to identify the most popular links to a specific page and to suggest where to insert new links to provide more direct access. In another embodiment, the access history is evaluated to determine traversed links leading to a purchase of a product made within commercial pages. This information may be used, for example, to charge for advertising based on the number of link traversals from an advertising page to a product page or based on the count of purchases resulting from a path including the advertisement. In this embodiment, the server can gauge the effectiveness of advertising by measuring the number of sales that resulted from a particular page, link, or path of links. The system can be configured to charge the merchant for an advertising page based on the number of sales that resulted from that page.

This portion of the specification, which the Examiner has chosen to ignore or not give any weight, clearly provides sufficient details for the programmer of ordinary skill in the art to write a program that counts the number of accesses to a product page and charges for advertising based thereon. Even more clearly, however, this portion of the specification describes a <u>specific method</u> for doing so by "filtering transaction logs from one or more servers to select only transactions involving a particular user ID (UID)." This "access history," which is stored in a computer-implemented "transaction log," is then evaluated in order to determine traversed links leading to a

purchase of a product. There *should be* no real dispute in view of this specific disclosure in the specification that a programmer of ordinary skill in the art could write a satisfactory program to carry out these steps with ordinary effort. Thus, for this additional reason, applicants maintain that the enablement rejection should be withdrawn.

II.   The Anticipation Rejection Over Ferguson Cannot Be Sustained in View of the Applicant's Rule 131 Affidavit

The Office Action continues to reject all of the pending sixty-three claims as being anticipated under 35 U.S.C. § 102(e) over the Ferguson patent. This rejection cannot be sustained, however, in view of the fact that the Applicants have sworn behind this reference as permitted by 37 C.F.R. § 1.131.

The Examiner contends that the 131 Affidavit is ineffective to overcome Ferguson because the reference allegedly claims the same patentable invention as this application. Applicant's strongly refute this allegation. First, *and foremost*, the Examiner has only attempted to demonstrate this alleged correspondence between Ferguson's claims and *one claim of the sixty-three pending claims in this application* – claim 41. Pages 3-4 of the Office Action set forth a claim chart purporting to demonstrate that claim 26 of Ferguson is the same as claim 41 of the present application. Neglecting for a moment that applicants do not agree that this claim chart demonstrates correspondence between the two claims, nowhere in the Office Action is any attempt made to demonstrate which claims of Ferguson correspond to the remaining *sixty-two* claims of the present application. Without such evidence, the PTO cannot possibly maintain that the Affidavit under 37 C.F.R. § 1.131 is "ineffective" with respect to the remaining claims of this application. In order for this rejection to be maintained, the Examiner would have had to show correspondence with respect to every claim for which prior invention is proven with the Affidavit. Thus, the anticipation rejection (at least with respect to claims 1, 4-40 and 42-65) should be withdrawn.

Furthermore, the anticipation rejection should be withdrawn because the claims of the present application are clearly not the same as the claims of Ferguson, as alleged by the Examiner with respect to claim 41. For example, even a cursory review of the claim chart set forth at pages 3-4 of the Office Action reveals many distinctions. Claim 41 recites, for example "means for determining a number of such determined link traversals leading from the first document to the second document." The Examiner alleges that this is the same as "means for storing the plurality of fee specifications using the editing means" in claim 26 of Ferguson, despite the fact that the words of these two elements have little in common, and are clearly distinct in meaning. Likewise, the Examiner contends that the phrase "wherein each of said fees is triggered by a defined user action" from claim 26 of Ferguson is the same as the "means for charging for advertising based on the number of link traversals to the second document" element of claim 41 of the present application. Once again, however, there does not appear to be any rational correspondence between these two phrases. The element of claim 41 is referring to charging "for advertising" whereas the allegedly-corresponding limitation from claim 26 of Ferguson is only generically referring to "fees." Because of these distinctions between the claims of the present application and those of Ferguson, the anticipation rejection should be withdrawn in view of the Applicant's Rule 131 Affidavit.

JONES DAY

David B. Cochran (Reg. No. 39,142)
Jones Day
North Point, 901 Lakeside Avenue
Cleveland, Ohio 44114
(216) 586-7029